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Paper No.

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SUITE 2800
ATLANTA GA 30309

MAILED

JUN 30 2010

OFFICE OF PETITIONS

In re Application of :
Peng et al. :
Application No. 10/763,068 : LETTER REGARDING
Filed: January 22, 2004 : PATENT TERM ADJUSTMENT
Docket No. 40715-296579 :
Title: MONODISPERSE CORE/SHELL AND :
OTHER COMPLEX STRUCTURED :
NANOCRYSTALS AND METHODS OF :
PREPARING THE SAME :

This is in response to the "Petition Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance" filed March 8, 2010. Applicants request that the determination of patent term adjustment be increased by three hundred (300) days to three hundred (300) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent. In addition, Applicants imply that one period of applicant delay should be changed from 57 days to 58 days.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not

undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, Applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that Applicants otherwise request reconsideration of the patent term adjustment at the time of the mailing of the

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

notice of allowance, the request is GRANTED to the extent indicated herein.

The Office has updated the PALM screen to reflect the change in one period of Applicant delay. The Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance remains zero days (366 days of Office delay less 490 days of Applicant delay). A copy of the updated PALM screen, showing the correct determination, is enclosed.

Applicants state that any patent issuing from the application is not subject to a terminal disclaimer.²

On February 16, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 0 days. On March 8, 2010, Applicants submitted the instant comment. Applicants have implied that the PTA Calculations in PAIR incorrectly calculates one period of Applicant delay.

A review of the application history reveals that Applicants are correct.

Specifically, pursuant to 37 C.F.R. § 1.704(b), the failure to reply to an Office action within three months is a failure to engage in reasonable efforts to conclude prosecution. A final Office action was mailed on October 23, 2007, and Request for Continued Examination (RCE) was filed on March 21, 2008, which is three months and 58 days after the mailing of the final Office action. As such, Applicants failed to engage in reasonable efforts to conclude prosecution of the application, and this delay totalled 58 days.

However the Office incorrectly used a filing date of March 20, 2008 for the RCE when calculating the period of Applicant delay. As such, the Office incorrectly determined that a period of 57 days of Applicant delay is associated with the submission of the RCE.

The Office thanks Applicants for their good faith and candor in bringing this to the attention of the Office.

² Petition, page 5.

The Applicant delay of 57 days associated with the submission of the RCE on March 21, 2008 has been removed, and a period of 58 days has been added.


The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanowski (571) 272-3225.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Wednesday

PALM INTRANET

Date: 6/30/2010

Time: 07:38:53

PTA Calculations for Application: 10/763068

Application Filing Date:	01/22/2004	PTO Delay (PTO):	366
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	489
Post-Issue Petitions:	0	Total PTA.(days):	0
PTO Delay Adjustment:	-1		

File Contents History

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101	06/30/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		1	
90	02/16/2010	MAIL NOTICE OF ALLOWANCE			
89	02/05/2010	ISSUE REVISION COMPLETED			
88	02/05/2010	DOCUMENT VERIFICATION			
87	02/05/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
86	02/05/2010	CASE DOCKETED TO EXAMINER IN GAU			
85	02/05/2010	EXAMINER'S AMENDMENT COMMUNICATION			
84	02/05/2010	NOTICE OF ALLOWABILITY			
83	01/14/2010	DATE FORWARDED TO EXAMINER			
82	11/25/2009	RESPONSE AFTER NON-FINAL ACTION		61	78
81	11/25/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
80	07/24/2009	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
79	07/22/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
78	06/25/2009	MAIL NON-FINAL REJECTION			
77	06/23/2009	NON-FINAL REJECTION			
76	06/19/2009	DATE FORWARDED TO EXAMINER			
75	06/18/2009	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
74	06/19/2009	DATE FORWARDED TO EXAMINER			
73	06/18/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)		91	64
72	06/19/2009	DISPOSAL FOR A RCE / CPA / R129			
71	06/18/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			

70	06/18/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
69	05/21/2009	MAIL ADVISORY ACTION (PTOL - 303)			
68	05/21/2009	ADVISORY ACTION (PTOL-303)			
67	05/20/2009	DATE FORWARDED TO EXAMINER			
66	05/19/2009	AMENDMENT AFTER FINAL REJECTION			
65	05/19/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
64	12/19/2008	MAIL FINAL REJECTION (PTOL - 326)			
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62	11/08/2008	DATE FORWARDED TO EXAMINER			
61	10/21/2008	RESPONSE AFTER NON-FINAL ACTION		91	58
60	10/21/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	04/22/2008	MAIL NON-FINAL REJECTION			
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53	03/20/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		57	49
52	03/25/2008	DISPOSAL FOR A RCE / CPA / R129			
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43	10/05/2007	CASE DOCKETED TO EXAMINER IN GAU			
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39	02/26/2007	RESPONSE TO ELECTION / RESTRICTION FILED		62	37
38	02/26/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
37	09/26/2006	MAIL RESTRICTION REQUIREMENT			

36	09/22/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
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31	08/23/2006	RESPONSE TO ELECTION / RESTRICTION FILED		61	29
30	08/23/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
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27	03/11/2005	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS			
26	12/14/2004	REFERENCE CAPTURE ON IDS			
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25	12/14/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
24	01/06/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
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22	10/15/2004	APPLICATION RETURN FROM OIPE			
21	10/18/2004	APPLICATION IS NOW COMPLETE			
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8	04/28/2004	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			

7	03/22/2004	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
6	03/22/2004	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
5	03/22/2004	REFERRED BY L&R FOR THIRD-LEVEL SECURITY REVIEW. AGENCY REFERRAL LETTER GENERATED			
4	03/09/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	03/09/2004	CASE CLASSIFIED BY OIPE			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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